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1   RECORD OF ORAL HEARING
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3   UNITED STATES PATENT AND TRADEMARK OFFICE
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6   BEFORE THE BOARD OF PATENT APPEALS
7   AND INTERFERENCES
8   _____
9
10   Ex parte LARS LANGEMYR, MAGNUS MARKLUND, ARNE
11   NORDMARK, PER-OLOF PERSSON, and MAGNUS RINGH
12   _____
13
14   Appeal 2008-1495
15   Application 09/675,778
16   Technology Center 2100
17   _____
18
19   Oral Hearing Held: April 17, 2008
20   _____
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22
23   Before MICHAEL R. FLEMING, Chief Administrative Patent Judge,

24   LEE BARRETT, ALLEN R. MacDONALD, LINDA E. HORNER, and

25   JOHN A. JEFFERY, Administrative Patent Judges

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27
28   ON BEHALF OF THE APPELLANT:
29
30
31   PETER J. PROMMER ESQUIRE
32   Nixon Peabody LLP
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35
36
37   The above-entitled matter came on for hearing on Thursday, April 17,

38   2008, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office,

1   600 Dulany Street, 9th Floor, Hearing Room A, Alexandria, by Diversified

2   Reporting.

3   P R O C E E D I N G S

4

5   JUDGE FLEMING: Mr. Prommer.

6   MR. PROMMER: Good afternoon.

7   JUDGE FLEMING: Good afternoon. We do have someone in the

8   gallery here. This is Denise. This is a patent attorney that is assigned to

9   judges here. With your permission, would it be all right for her to stay?

10   MR. PROMMER: Yeah. Yeah, that's fine, Your Honors.

11   JUDGE FLEMING: You may proceed when you're ready.

12   MR. PROMMER: Can I please just have a few minutes just to set up?

13   JUDGE FLEMING: Yes.

14   JUDGE MaCDONALD: Excuse me. Is this your first time here?

15   You know how it works, in other words?

16   MR. PROMMER: Yes. Are we on the record?

17   COURT REPORTER: Yes.

18   MR. PROMMER: I feel a little bit of divine inspiration with the Pope

19   being in town, for having a clear hearing room and for having five judges

20   here, as well. As I understand, it's normally three.

21   (Pause.)

22   JUDGE FLEMING: Proceed.

23   MR. PROMMER: Thank you, Your Honors.

1   I'm Peter Prommer, Reg Number 54743, representing the applicant,

2   Lars Langemyr, et al. The real party in interest is ComSol, Inc.

3   At issue in this appeal is the examiner's erroneous conclusion that

4   claims one, three through 87 and 89 through 101, as the examiner states,

5   preempt every substantial practical application of an algorithm and do not

6   produce a tangible result.

7   Now, in coming to this conclusion, the examiner focuses his rejection

8   on claim recitations outputting the model of a combined physical system

9   based on a combined set of partial differential equations whereby the model

10 represents a mathematical expression of the physical quantities of the

11 combined physical system.

12   While doing this, the examiner appears to be in wholesale ignoring

13 that each of the independent claim recite either that we have a computer-

14 readable medium having stored thereon instructions for creating a model of a

15 combined physical system or in other independent claims we have a method

16 executed in a computer apparatus for creating a model of a combined

17 physical system.

18   Now, starting first with the preemption issue, the examiner relies

19 heavily on Gottschalk v. Benson in support of his incorrect allegation that

20 we're trying to patent every substantial practical application and there's

21 further allegation that we're wholly preempting a mathematical formula.

22   In fact, the examiner states that the claims in Gottschalk and the ones

23 pending before this Board share the same characteristics.

1   The claims in the Gottschalk generally recite a method of converting

2   signals from binary code decimal form into binary form which comprises the

3   steps of storing the decimal signal in a register along with the steps of

4   shifting the signal and massing and adding a binary one.

5   Now, the Gottschalk court found the claims in that case problematic

6   because it wholly preempted the mathematical formula for converting binary

7   coded decimal numerals to pure binary numerals.

8   JUDGE HORNER: Do you think the outcome in Benson would have

9   been different if it had included a step that said "outputting a number?"

10   MR. PROMMER: Well, potentially yes.

11   JUDGE HORNER: Why?

12   MR. PROMMER: Going to the outputting step, it kind of ties into the

13   tangible result argument that the outputting step allows for I guess a tangible

14   result.

15   JUDGE MacDONALD: What's tangible about it?

16   MR. PROMMER: Of outputting?

17   JUDGE MacDONALD: Of outputting. Where does it output to?

18   What is the product or --

19   MR. PROMMER: Well, the one problem I think with Benson, too, is

20   that we have the method without being tied to any type of a machine.

21   Now, in our case, we do have the method tied to the machine and the

22   specification does include examples of outputting.

4

1   JUDGE FLEMING: Why wouldn't it be tied to a machine when it's

2 referring to shift registers?

3   MR. PROMMER: I'm sorry.

4   JUDGE FLEMING: Didn't Benson refer to shift registers?

5   JUDGE BARRETT: There were two claims in Benson. One was just

6 a pure method. The other one actually talked about doing the method on

7 something with shift registers.

8   MR. PROMMER: I believe the court estimated the interpretation

9 though that this could have been I think completed by hand, I think, or it

10 could have been done outside the machine realm.

11   JUDGE MacDONALD: But I think ultimately they said the only real

12 use for it is in a computer environment and you're preempting every use of

13 that, every practical application.

14   MR. PROMMER: Right.

15   JUDGE MacDONALD: Looking at your claim one, I'm trying to --

16 the outputting that you're talking about, how is Benson implemented without

17 outputting? Isn't that part of every process and what is not included in,

18 executed in a computer apparatus? Isn't that every way of doing this?

19   MR. PROMMER: Are you referring to our claim or to the Benson

20 claims?

21   JUDGE MacDONALD: Your claim, putting in the "executed in a

22 computer apparatus." I just don't see how it's limited down to less than

23 everything.

1   MR. PROMMER: Well, I think it comes back to that the examiner

2   just seems to be ignoring the computer apparatus component of our claims in

3   the sense that we're wholly pre-empting use --

4   JUDGE MacDONALD: Well, that's what I'm asking. Why is that

5   not the case taking into consideration? How is not preempted? How was

6   this used in any other environment other than a computer apparatus? Isn't

7   that the only practical application of this process? Doesn't it always have to

8   include outputting?

9   MR. PROMMER: I guess I would say no. It could solve the partial

10   differential equations by hand, going back to --

11   JUDGE MacDONALD: But that's not a substantial practical

12 application of this, given the complexity of it. Isn't really the only use of

13 this, only substantial use of this in a computer apparatus?

14   MR. PROMMER: I guess we're coming back to: You're saying that it

15 wholly preempts every substantial application. That's the cases in the court;

16 and I think the key word being "every." The word "every" means every; so,

17 every minus one is not every.

18   JUDGE MacDONALD: But it has to be a substantial -- that one has

19 to be substantial. Your one example is doing this by hand. That might take

20 you ten years.

21   MR. PROMMER: But I think there are simplified forms of the partial

22 differential equations, as well, that could be solved by hand if you put it, for

23 instance, in academic or classroom type environment.

6

1   JUDGE MacDONALD: So, trivial examples can be done by hand?

2   MR. PROMMER: Well, I guess I wouldn't consider academics to

3   necessarily be trivial when students are learning in the classroom. I wouldn't

4   consider that to be trivial. And the short answer is, we're not preempting

5   somebody to do this by hand.

6   JUDGE FLEMING: Do you have a transformation in this claim?

7   MR. PROMMER: I'm sorry. A transformation? Can you clarify

8   that?

9   JUDGE FLEMING: In the Diehr sense.

10   JUDGE BARRETT: There's a case up at the Federal Circuit right

11 now, In re: Bilski.

12   MR. PROMMER: Correct.

13   JUDGE BARRETT: One of the questions there is, what should the

14 test be for statutory subject matter?

15   MR. PROMMER: Mm-hum.

16   JUDGE BARRETT: And you know, one of these argues that it

17 should be transformation of subject matter from one state to another.

18 Cochrane v. Deener; Diamond v. Diehr. If that's the test, what is the

19 transformation that's going on here?

20   MR. PROMMER: I guess I'd have to, you know, read through the

21 claims. We are combining a set of partial differential equations and then --

22   JUDGE BARRETT: Well, let's just take claim one.

23   MR. PROMMER: I'm sorry.

1   JUDGE BARRETT: Take claim one.

2   MR. PROMMER: Right.

3   JUDGE BARRETT: Can you identify a transformation of an article

4 into a different state of thing?

5   MR. PROMMER: Well, it's a method claim incorporated in the

6 computer apparatus. We're taking this representation of the physical system

7 as application. You're determining partial differential equations for the

8 application and then forming this combined set of partial differential

9 equations using the determined -- I'll use "PDE" for partial differential

10 equations just to save my voice. Using determined PDEs for the systems

11 that were represented and then we're outputting the model of that combined

12 physical system.

13   JUDGE FLEMING: What does "outputting the model" mean?

14   MR. PROMMER: You would have to take that into specification and

15 going into the spec using claim differentiation principles. Just as examples,

16 you could take a look at figure one and figure two of the application. It

17 shows a host. It shows user interface, storage and retrieval module.

18   JUDGE FLEMING: So, it's just simply a display of a number?

19   MR. PROMMER: I think that could be one example of the output;

20 and if you go into the --

21   JUDGE BARRETT: It's broad enough to just simply be the number?

22   MR. PROMMER: I'm sorry.

1   JUDGE BARRETT: It's broad enough to just simply be displaying

2 the number?

3   MR. PROMMER: Well, we also have the graphical-user interface

4 deeper in the claims.

5   JUDGE BARRETT: Yeah; but then this claim one.

6   MR. PROMMER: Right.

7   JUDGE BARRETT: So, claim one is not necessarily displaying?

8   MR. PROMMER: Not necessarily.

9   JUDGE BARRETT: And so, outputting a model could be just

10 outputting combined partial set of equations. So, you take a set of partial

11 differential equations. You do operations on them. You combine them;

12 form a set of partial differential equations that represents a model of this

13 physical system.

14   MR. PROMMER: Correct.

15   JUDGE BARRETT: And you output this set of differential

16 equations?

17   MR. PROMMER: With the model.

18   JUDGE BARRETT: But the model -- isn't that just some sort of

19 mathematical representation? It's not necessarily anything more than that in

20 this; is it? There's no displaying going on?

21   MR. PROMMER: It depends what you're -- ultimately it would

22 probably be up to -- it would be a claim construction issue displaying, I

9

1   guess, maybe outside of the realm, using graphical-user interface to display.

2   Yes, that claim one would include that.

3   JUDGE FLEMING: Well, we're asking you what would that be? It

4   has to be something different than a graphical interface.

5   MR. PROMMER: It would be something that somebody skilled in

6   the art would know. Maybe a sheet of paper.

7   JUDGE FLEMING: A sheet of paper?

8   MR. PROMMER: It could be to another device. It could be --

9   JUDGE BARRETT: It could be like State Street where the outputting

10   was -- it was really just in the machine; right? It didn't have any effect on

11   the external world. It says, "Outputting a model." It says, "The model

12   represents a mathematical expression of the physical quantities of the

13   combined physical system." So, that's what you're representing. Your

14   outputting is this mathematical expression; and you're not necessarily

15   displaying it in a -- we're trying to see if there is any physical step that's

16   going on here, and it looks like "outputting" is broad enough to just say that's

17   the result of these previous steps in the machine.

18   JUDGE JEFFERY: Could outputting simply be providing the model

19   in some way, shape or form, say from an electronic component, a signal

20   perhaps?

21   MR. PROMMER: I guess maybe is more the question, is the signal

22   what's --

23   JUDGE JEFFERY: Yeah.

1   MR. PROMMER: Or were you trying to patent the signal or --

2   JUDGE JEFFERY: Just trying to get a handle on "outputting."

3   MR. PROMMER: Okay. I guess I would qualify it as we're not

4   trying to patent a signal here, going to, I

5   think -- is it Nuitjen?

6   JUDGE JEFFERY: Fair enough. We're not providing a model in

7   some way, shape or form. Outputting --

8   MR. PROMMER: Well, outputting I think I would refer to our

9   computer apparatus.

10   JUDGE FLEMING: Why would this be nothing more than just

11   simply, once you have formed the combined partial differential equations

12   that's what you're providing?

13   MR. PROMMER: I'm sorry?

14   JUDGE FLEMING: Why couldn't outputting be so broad to include

15   just any way in which you provide the result of the former step which is

16   forming the combined set of partial differential equations?

17   MR. PROMMER: I guess I wouldn't disagree with that assessment.

18   JUDGE FLEMING: So, it's a very broad last step?

19   MR. PROMMER: Well, it would be based on what one of ordinary

20   skill in the art would understand. We have disclosures within our

21   specification, particularly, you know as examples, figure one and figure two;

22   and we also have dependent claims 14, 54, 26, 66 that discuss the graphical-

23   user interface. They discuss storing input data in the memory.

1   JUDGE FLEMING: Were those argued separately?

2   MR. PROMMER: They were called out within the appeal brief.

3 They were specifically identified. Were they under their own header? No.

4 But they were specifically identified in the appeal brief.

5   One other thing, too, getting back to the whole hand calculation issue:

6 One thing that was interested in the Bilski case was -- if you can bear with

7 me here for a moment, unless my minutes are running low.

8   I know in that case, the Patent Office itself, the Patent Director, PTO

9 Director, addressed an issue. Ah, yes. Okay. The PTO Director in his

10 March 6, 2008 supplemental briefing in the Bilski case which is now being -

11 - I think it's up before the Federal Circuit.

12   On page five of his supplemental brief, he chides Bilski in a similar

13 context as the examiner has done, stating that Bilski's claim is so broad to

14 include a non-machine-implementing method of achieving goals, negotiate

15 number in the commodity contracts. To me that interprets that the PTO

16 Director has made the determination that there is this distinction of doing

17 things on computers and doing them outside of computers, be it a hand

18 calculation. So, that's just one thing that I wanted to point out, as well.

19   JUDGE BARRETT: Would it make a difference if this claim one

20 were not performed on a computer, if you just took that language out,

21 "executed in a computer apparatus"? Would that be statutory; do you think?

1   MR. PROMMER: Based on certain case law that could potentially be

2   problematic. I think we added in some of the computer implementations in

3   our claim amendments, in our narrowing amendments to independent --

4   JUDGE FLEMING: In claim one what other language are you

5   relying on in method steps and putting in computer apparatus?

6   MR. PROMMER: Other than the preamble? I think the computer

7   apparatus --

8   JUDGE FLEMING: It would then just be intended use?

9   MR. PROMMER: I'm sorry.

10   JUDGE FLEMING: Why would not this be intended use since there

11   is no structure tied to the --

12   MR. PROMMER: Well, it's a computer apparatus specifically for

13   creating a model of the combined physical system.

14   JUDGE FLEMING: The Federal Circuit has a whole line of case law

15   talking about what weight should be given to the preamble.

16   MR. PROMMER: I agree.

17   JUDGE FLEMING: And they said that the method steps have to give

18   life and meaning to the preamble. Where is the life and meaning of this

19   preamble.

20   MR. PROMMER: Well, specifically, based on antecedent principles.

21   We have a combined physical system which is later referred to in the method

22   claim elements as "by the." So, we go from "a" to "the."

1   I also have a citation to a 1990, Fed. Circuit case which specifically

2 addresses this issue.

3   JUDGE FLEMING: That's directed to the model; correct? And I

4 thought we just went through that concept that that model is just

5 representing physical qualities.

6   MR. PROMMER: I'm sorry. What? A model?

7   JUDGE FLEMING: In your preamble you say, creating a model of a

8 combined physical system.

9   MR. PROMMER: Correct.

10   JUDGE FLEMING: So, that's directed to the model, not to the

11 computer apparatus.

12   MR. PROMMER: But the model is created on the computer

13 apparatus.

14   JUDGE HORNER: But wouldn't your "outputting a model step" say

15 "outputting the model" if you were referring back to the model in the

16 preamble that was executed by the computer?

17   (Pause.)

18   MR. PROMMER: That's certainly a good point. It could be a point

19 for an amendment. I think you may have actually identified an antecedent-

20 basis issue where it should be "the model."

21   And just to refer you to the case regarding preambles, it's Gerber

22 Garment Technology and that's 916, F. 2nd, 683. The pinpoint is at 689 and

1 that's Fed. Circuit, 1990. In that case, the Fed. Circuit noted that preamble

2 recitations provided antecedent bases for terms used in the body of a claim.

3   JUDGE BARRETT: Does it make any difference that the partial

4 differential equations represent physical quantities? Is that important? I

5 mean, because after all, they're still going to be just mathematical

6 expressions. Does it make any difference that there represents something

7 physical as opposed to --

8   MR. PROMMER: I think as far as getting your tangible result. I

9 think that would be yes.

10   JUDGE BARRETT: Are they actually representing something in

11 particular? This is a general differential equation in that maybe in a

12 particular example they would but the claim is not limited to any particular

13 field, like for instance at State Street representing a share price or something

14 of that nature. This is just in general.

15   MR. PROMMER: In our specification -- I believe it's on page 16 --

16 we did identify numerous examples.

17   JUDGE BARRETT: Examples could be made. But this is a general

18 tool to be used in all fields of endeavor; correct?

19   MR. PROMMER: For modeling a physical system --

20   JUDGE BARRETT: So, any physical system?

21   JUDGE MacDONALD: Are these actual physical systems or

22 theoretical physical systems?

1   MR. PROMMER: One place where the claims do not include

2   applications would be such areas as certain quantum field theory

3   applications, such as annihilation of elementary particles and high energy

4   physics or string interactions and super strength theory. Then we come back

5   to, we're not wholly preempting every use, sort to say, of partial differential

6   equations.

7   JUDGE MacDONALD: But physical quantities would encompass all

8   of those; right?

9   MR. PROMMER: I'm sorry.

10   JUDGE MacDONALD: Representing physical quantities would

11   represent everything. So, the fact that there is some species in there not

12   specifically enumerated in your specification doesn't mean it doesn't cover it.

13   The claim would still cover everything; right?

14   MR. PROMMER: I guess as far as how broad we go, that would

15   again kind of come -- it comes down to a claim construction issue and things

16   could change on that. The law could change on that.

17   But you're right now. We have the disclosures and the specification,

18   and it would. Physical systems would comprise those situations.

19   JUDGE MacDONALD: Talk about method claim ten. You say,

20   "displaying partial differential equations." Is it your position that displaying

21   is tangible result, that it's an additional tangible result?

22   MR. PROMMER: On top of the outputting, yes.

1   JUDGE MacDONALD: Because the outputting nobody would ever

2 have to see; right? They could be just in the machine?

3   MR. PROMMER: I don't know the answer to that question. I can't

4 answer that.

5   JUDGE MacDONALD: What do you think the Federal Circuit means

6 by "tangible?"

7   MR. PROMMER: If you can bear with me here for a minute.

8   (Pause.)

9   MR. PROMMER: I guess if we take a look at the example that the

10 examiner provided. He cited to In re: Warmerdam in doing his tangible

11 analysis.

12   JUDGE MacDONALD: In Warmerdam?

13   MR. PROMMER: I'm sorry.

14   JUDGE MacDONALD: I was just trying to get clarification. What

15 did you just say?

16   MR. PROMMER: The examiner cited In re: Warmerdam.

17   JUDGE MacDONALD: In?

18   MR. PROMMER: In completing his -- whether we cite a tangible

19 result analysis.

20   JUDGE MacDONALD: So what about In re: Warmerdam? Why is

21 your claim different there?

22   MR. PROMMER: Well, number one -- is the whole panel familiar

23 with Warmerdam or should I go through the claim itself?

1   JUDGE MacDONALD: We're familiar.

2   MR. PROMMER: I'm sorry.

3   JUDGE FLEMING: We're all familiar with it.

4   MR. PROMMER: Okay. I guess what's interesting about

5   Warmerdam is that they held independent claim one was not patentable

6   subject matter but the court held that dependent claim five was patentable --

7   JUDGE MacDONALD: But five was a machine.

8   MR. PROMMER: Correct.

9   JUDGE MacDONALD: You're not claiming a machine. This is a

10 method. So, the methods went down, did it not, in Warmerdam?

11   MR. PROMMER: But it's a method being -- let me get the exact

12 wording. It's a method executed on a computer, in a computer apparatus.

13   JUDGE MacDONALD: So, that's what you're holding? It's the only

14 difference between the two?

15   MR. PROMMER: Well, that's for one independent claim and then we

16 also have the computer readable medium claims, as well, which would be a

17 physical item.

18   JUDGE MacDONALD: But isn't that really form over substance with

19 respect to the medium? If the claim is unpatentable without the medium,

20 why is it suddenly made patentable by putting an unpatentable process on a

21 medium?

22   MR. PROMMER: I guess I'm not one to question the wisdom in

23 Beauregard.

18

1   JUDGE FLEMING: Was Beauregard actually precedent?

2   MR. PROMMER: I believe it governs.

3   JUDGE MacDONALD: It was not decided.

4   MR. PROMMER: I'm sorry.

5   JUDGE MacDONALD: Beauregard was not decided. It's still an

6   open question.

7   MR. PROMMER: I don't know that much about the case to make that

8   interpretation.

9   JUDGE MacDONALD: It was simply returned back to the office to

10 do whatever; was it not? Could the Federal Circuit actually have ruled that

11 all computer disks by definition -- claims would be statutory?

12 MR. PROMMER: I don't know. I guess I could accept your representation

13 that that was the case. I wouldn't have any reason to not agree with you.

14 The Beauregard context probably came -- may have come out of dicta, out

15 of the case.

16   JUDGE FLEMING: I guess my question is that the Flook claim in

17 which maybe the -- the result of the Flook claim is that it was held to be non-

18 statutory. Why is your claim different than the Flook claim?

19   MR. PROMMER: I'm not familiar with the exact wording of the

20 Flook claim. Would you happen to have it?

21   JUDGE FLEMING: It's directed to a general manipulation of

22 equations in which they had a preamble. It was directed to a method of

23 obtaining a value of at least

1   one -- on at least one process variable involved in the process comprising the

2   catalytic chemical converters of hydrocarbons. That certainly -- it was

3   pretty physical.

4   MR. PROMMER: The physical component meaning the catalytic

5   converter process or was it --

6   JUDGE FLEMING: Getting data having to do with representing

7   having to do with representing real-world things having to do with the

8   chemical converting process.

9   MR. PROMMER: It's a process. In that claim I don't hear the

10   specific element of for instance a computer apparatus in that context. I don't

11   hear the term, catalytic converter. The physical object, if I heard the claim

12   correctly, is not here, and --

13   JUDGE FLEMING: So, just simply having the magic words in the

14   preamble, having implemented on a computer, is enough to distinguish your

15   claim from Flook?

16   MR. PROMMER: Well, it's a machine, a process or a method that's

17   completed on a machine. So, does that have sufficient, tangible -- I would

18   say yes and having the output component.

19   JUDGE FLEMING: If E equals MC squared, if we could agree that

20   that is an abstraction.

21   MR. PROMMER: Mm-hum.

22   JUDGE FLEMING: Why then would you be not entitled to a claim

23   that says your same preamble calculated equals MC squared?

1   MR. PROMMER: Because it's a law of nature.

2   JUDGE FLEMING: But it's on a computer. You just said that your

3   whole premise is the preamble saying that it's on a computer.

4   MR. PROMMER: I guess I come back to we're not -- we're not

5   claiming "equals MC squared" or we're not claiming partial differential

6   equations, per se. We're claiming this overall method of representing

7   physical systems. We incorporate parameters from our quantities from

8   physical systems --

9   JUDGE FLEMING: So, it's not simply because it's on a computer

10   that made it statutory, a method, your language -- let me make sure I have it

11   right. I don't want to misrepresent. "A method executed in a computer

12   system," or a computer apparatus is your claim. That doesn't make it

13   statutory?

14   MR. PROMMER: It helps. I think combined with the other items as

15   far as the outputting component, the fact that we are representing physical

16   systems and not representing abstracts.

17   JUDGE FLEMING: You're saying language, "method executed in a

18   computer apparatus" and, say, calculating E equals MC squared and

19   displaying the answer, that's enough?

20   MR. PROMMER: E equals MC squared is abstract. We're actually

21   tying this to combined physical --

22   JUDGE FLEMING: So, partial differential equation steps are not

23   abstract?

21

1   MR. PROMMER: But it includes modeling or representing the

2 physical systems though.

3   JUDGE FLEMING: Well, so did Flook.

4   MR. PROMMER: But Flook was missing certain components. It was

5 missing the apparatus component. If I heard the claim correctly, I don't

6 think that I heard --

7   JUDGE JEFFERY: Let me make sure I understand what you're

8 saying. If you took the claim of Flook and inserted in the preamble

9 "executed in a computer apparatus," and leave everything else the same,

10 updating the alarm limit, calculating the alarm limit, you're saying that

11 would be statutory?

12   MR. PROMMER: If there is some tangible result from that, I guess

13 that could be used in a real-world context.

14   JUDGE JEFFERY: The alarm limit calculated in a computer? Flook

15 is calculating an alarm limit using mathematics. I'm just trying to

16 understand. If you do that on a computer, only recited in the preamble in

17 fashion done in claim one, would that be statutory?

18   MR. PROMMER: If you outputted the alarm limit, I would think

19 combined with it being done on the computer apparatus -- I think that that

20 would be statutory, as I understood the claim.

21   JUDGE JEFFERY: But if you took out the outputting step? Non-

22 statutory?

23   MR. PROMMER: I think you start getting into very gray territory.

1   JUDGE FLEMING: Do you want to discuss your claim 26?

2   MR. PROMMER: Well, certainly it's an additional limitation on

3   independent claim one. We're adding in the graphical-user interface

4   component.

5   I guess I could go through this but I may just be regurgitating the

6   claims. Is there anything specific to claim 26 other than it adds additional

7   subject matter into independent claim one.

8   JUDGE HORNER: Can steps, claim 26, be implemented in any

9   computer system? Are you claiming a particular computer system in "26?"

10   MR. PROMMER: Well, I think it certainly gets more specific and it

11   adds in the graphical-user interface.

12   JUDGE FLEMING: Doesn't all computer systems have a graphical

13   interface?

14   MR. PROMMER: I don't believe so. Maybe a stand-alone PC would.

15   Maybe what we are more traditionally used to understanding as a computer

16   would be but I don't think all computer systems necessarily have the

17   graphical-user interface.

18   JUDGE MacDONALD: Stated a different way: If they have an

19   interface is't it a graphical-user interface?

20   MR. PROMMER: I would have to look at the technical term for

21   graphical-user interface but I think it generally at least encompasses a

22   physical screen.

1   JUDGE MacDONALD: No. I'm saying, if you have a screen, don't

2 you have a graphical-user interface? Isn't that a generic device that really

3 covers all interfaces?

4   MR. PROMMER: I would have to look up the definition of

5 graphical-user interface which I did not for these purposes. But I guess it

6 wouldn't surprise me at all if it included a display screen or a monitor.

7   JUDGE MacDONALD: Also, in the second step it's storing said

8 input data in a representation in a data structure, stored in the memory of a

9 computer, of the computer system. Is there any way to store this

10 information, this input data in the memory of a computer system without

11 putting it into a data structure? In other words, isn't this inherent to storing it

12 into any memory, that you have to put it in some form of data structure?

13   MR. PROMMER: I don't know the answer to that question.

14   Just coming back to graphical-user interface, are there other ways of,

15 say, outputting? I guess certainly if a computer had its output as a sound,

16 that would not be graphical. That could be one example.

17   I'm just going to draw a hypothetical here but let's use a traffic light

18 that's set up to accommodate people who are blind. Certainly that -- there

19 could be a computer that operates that and that just outputs to assist the blind

20 people.

21   JUDGE FLEMING: Well, are you suggesting that your claim is

22 encompassing that?

24

1   MR. PROMMER: I'm just throwing that out as a hypothetical, that

2   graphical-user interface has a more limited context.

3   JUDGE FLEMING: How does this further limit your claim one?

4   MR. PROMMER: I guess I would have to refer just -- I'd be routing

5   back to claim two and that's really the additional limitations.

6   JUDGE FLEMING: These are words. What do they really mean and

7   what is the structure that is directed?

8   MR. PROMMER: Well, we are still in the context of the preamble

9   which has the method executed in a computer apparatus. So, we're still

10 within that method and this is all executed within the computer apparatus.

11 So, the user component would be within the context of the computer

12 apparatus. The storing component would be within that context as -- and

13 converting component.

14   JUDGE FLEMING: Would you like to sum all of this up? I guess

15 first I should ask the panel if they have any other questions.

16   (No response.)

17   MR. PROMMER: Yes. I guess the only area that we really haven't

18 touched on is just the fact that we amended the claims numerous times. I

19 think there were four or the independent claims were narrowed four times, in

20 addition to trying to overcome the 101 rejection, to overcome prior art that

21 was cited by the examiner in which we did provide persuasive arguments

22 and we did overcome 102 and 103 rejection in the sense that that does create

23 the prosecution history estoppel which means that going forward we can't in

25

1   the future interpret the claims in a way that's inconsistent with that estoppel

2   which essentially means that at some level we have narrowed the breadth of

3   the claims, and this goes back to the preemption issue which we completely

4   disagree with.

5   I think with that, the Board has asked great questions and I've

6   addressed a lot of points that I had in the presentation that I prepared for

7   today; and I think for at least those reasons, we maintain that the examiner's

8   101 rejection in this case was improper, and I think we will all eagerly await

9   the Bilski decision.

10   JUDGE FLEMING: Okay. Thank you very much.

11   MR. PROMMER: Thank you.

12   JUDGE FLEMING: We appreciate it.

13   MR. PROMMER: Thank you. Thank you, Your Honors.

14   (Whereupon, at approximately 1:45 o'clock, p.m., the proceedings

15   were concluded.)